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PATENT APPLICATION *AF*

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Abbie Parker

Confirmation No.: 9307

Application No.: 10/033,622

Examiner: Chen, Alan

Filing Date: 12-27-01

Group Art Unit: 2182

Title: System and Method for Print Outcome Notification

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 11-1-05.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

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Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Abbie Parker

Group Art Unit: 2182

Serial No.: 10/033,622

Examiner: Chen, Alan

Filed: December 27, 2001

Docket No. 10015505-1

For: **System and Method for Print Outcome Notification**

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed November 1, 2005 has been carefully considered. In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

The Examiner has provided in the Examiner's Answer various responses to arguments contained in Applicant's Appeal Brief. In particular, the Examiner attempts to refute Applicant's arguments regarding Moro's alleged teaching as to "determining whether one or more of the print driver settings is likely to adversely affect the quality of images printed on the print media ". Applicant addresses the Examiner's arguments in the following.

In the Examiner's Answer, the Examiner argues that the Applicant is wrong as to Moro not teaching "determining whether one or more of the print driver settings is likely to adversely affect the *quality of images printed on the print media*" (emphasis added). In particular, the Examiner reiterates his argument that Moro's teaching as to determining whether there is a mismatch between a printer driver setting and a printer condition in regard to paper size and ink color equate to "determining whether one or more of the print driver settings is likely to adversely affect the quality of images printed on the print media".

A. Claim Interpretation

As an initial matter, the Examiner argues that the claims are to be given the broadest reasonable interpretation *in light of the specification*. Examiner's Answer, page 6, lines 5-8. Applicant agrees that the claims are to be *reasonably* interpreted *in light of the specification*. Indeed, it is well established in the law that claim terms are to be interpreted in light of the specification. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995)(in banc), *aff'd*, 517 U.S. 370, 38 USPQ2d 1461 (1996) ("Claims must be read in view of the specification, of which they are a part"). However, the Examiner's interpretation of "adversely affect the quality of images printed on the print media" is *not* reasonable in light of

Applicant's specification. Specifically, when the specification is considered, it is clear that the meaning of "adversely affect the quality of images printed on the print media" refers to the well-established definition of "print quality" that is commonly used in the printing arts. For example, on page 10 of the specification, Applicant indicates that poor print quality can occur when "use of recycled media, use of relatively thick media (to which it can be difficult to adhere toner), use of rough-textured media, use of an economy mode in which less toner is used in print jobs, etc." are practiced. Applicant's specification, page 10, lines 12-15. Clearly, Applicant is referring to situations in which the printed image provided on the page is poor, for instance due to difficulty in adhering toner to the page or due to use of too little toner.

B. Moro's Teaching as to Paper Size

Printing on the wrong size paper has nothing to do with print quality. Regarding printing on the wrong size paper, the user may end up with, say, an A4-sized document instead of a letter-sized document, but this would not "adversely affect the quality of images printed on the print media". Specifically, the image quality that appears on the A4-sized paper would be the same as it would be on the letter-sized paper. Only the paper size would be different.

Regarding the Examiner's statements on page 10 of the Examiner's Answer as to page size, the comparison of an "economy mode" as is described in Applicant's specification and paper size as is described in the Moro reference are not the same. In particular, an economy mode clearly would affect print quality (i.e., it would reduce it), while printing on the wrong size paper would clearly not affect print quality. Furthermore, the Examiner's arguments as to an image being cropped is not supported by Moro or the other prior art of record. Examiner's Answer, page 10, lines 14-16. This argument is made for the first time by the Examiner in the

Examiner's Answer in an attempt to characterize Moro as teaching Applicant's claimed invention, which Moro clearly does not. Regardless, such a result would not equate to adversely the "quality of images *printed on the print media*" (emphasis added). The Examiner is ignoring Applicant's explicit claim limitations. Specifically, that a portion of the print image is cropped would not result in the images that are "printed on the print media" to have adversely-affected quality.

C. Moro's Teaching as to Monochrome vs. Color

Regarding printing in monochrome instead of color, the Examiner argues that "the quality of a printed flower is much better with color photograph print than the black and white image print." Examiner's Answer, page 6, lines 13-15. Applicant disagrees. There are many professional photographers and photography enthusiasts that would say the opposite. In particular, many prefer a black and white prints *over* a color prints. This is one reason that black and white photographic prints are so popular. Regardless, the fact remains that the print quality would be the same. Only the color of the print would be different. The Examiner's personal preference for color images does not change this fact and cannot be relied upon in rejecting Applicant's claims.

As for the Examiner's argument that Anderson (U.S. Pat. No. 6,644,800) supports the Examiner's opinion that color images are better (Examiner's Answer, page 6, lines 15-end), Applicant notes that Anderson discusses print quality in terms of creating images "using ink drops of relatively small volume in an effort to increase sharpness and achieve a photo print quality level of detail." See Anderson excerpt produced on page 6 of the Examiner's Answer. Therefore, Anderson is *not* describing print quality in terms of monochrome versus color.

Instead, Anderson is discussing achieving better quality by *using smaller droplets of ink*. Nothing in the Anderson reference states that the same level of quality could not be achieved by using the same small droplets of ink when printing in monochrome. This reveals the Examiner's lack of understanding of the term "quality" in the printing arts. At issue is not whether color images are subjectively "better" than monochrome. At issue is the *quality* of printed image in the absolute sense, irrespective of the image's color.

Regarding the Examiner's continued reliance on the dictionary definition of "quality" (Examiner's Answer, page 7, lines 3-5), Applicant again notes that Merriam Webster's definition of "quality" is not controlling. The meaning of the phrase "quality of images printed on the print media" is to be judged in light of the meaning of the term *in the art in light of Applicant's specification*. Once more, the meaning of the term is that which would be accorded by a person having ordinary skill in the printing arts in light of Applicant's specification. Therefore, the meaning cannot be judged in a vacuum relative to an extrinsic source such as a dictionary. Moreover, the definition "degree of excellence" is subjective. Accordingly, even if the dictionary definition were used to interpret the claim limitation, it is not proper for the Examiner to conclude that color images have a higher "degree of excellence" than monochrome images. Again, it is completely reasonable for an observer to consider a black and white image to have a higher "degree of excellence" than a color image. This is why black and white photographs are often preferred over color photographs in the art world. The Examiner's personal opinion is not the standard by which to interpret the claim limitation.

D. “Resolution”

On page 7 of the Examiner’s Answer, the Examiner next argues that Applicant is attempting to describe “resolution” of the printed page. Examiner’s Answer, page 7, lines 12-14. Applicant disagrees. In the printing arts, resolution refers to the resolution at which an image is printed. For example, a common resolution is 600 dots-per-inch (dpi). Applicant notes that, even when an image is printed with a high resolution, such as 1200 dpi, an adverse print result may still occur if, for example, rough-textured media were used. In particular, despite the high-resolution setting, toner may not adhere to the page well, thereby creating an adverse printing result. Therefore, resolution is not necessarily dispositive.

Even if one were to argue that “resolution” of the resultant printed image were the issue, Applicant again asserts that the phrase “quality of images printed on the print media” distinguishes over Moro when the phrase is properly interpreted in light of the specification from the viewpoint of a person having ordinary skill in the art. Moreover, Applicant disagrees that the specification uses “very open-ended language regarding print quality”. See Examiner’s Answer, page 7, line 17. As was indicated above, page 10, for example, provides a clear indication of what an adverse print result in terms of quality entails. Applicant’s inclusive comments, which are common in patent applications, as to persons having ordinary skill in the art understanding that other print settings may adversely affect print quality do not change the nature of the clear meaning of what qualifies as “affecting print quality.” Furthermore, Applicant disagrees that Applicant “intended leave ‘quality of image’ to be broad” (see Examiner’s Answer, page 8, lines 10-11), and will let the specification speak for itself.

E. “Admission” as to Moro’s Teachings as to Comparison

The Examiner’s comments on page 9, lines 1-19 of the Examiner’s Answer regarding Applicant’s alleged “admission” as to Moro’s teaching as to comparison of driver settings to a printer state is irrelevant to the issue at hand. Again, Moro does not teach or suggest “determining whether one or more of the print driver settings is likely to adversely affect the quality of images printed on the print media”. Given that fact, Moro does not render Applicant’s claims obvious.

F. Print Speed

On pages 10 and 11 of the Examiner’s Answer, the Examiner addresses the limitation “determining whether one or more of the print driver settings is likely to adversely affect . . . *the speed at which printing is performed*” (emphasis added). Regarding that limitation, the Examiner states that “It is well established to one of ordinary skill in the art that color printing in [*sic*] intrinsically slower than b/w printing”. Examiner’s Answer, page 10, line 22 to page 11, line 2. Applicant disagrees with this statement and furthermore asserts that such an unsupported allegation cannot be relied upon in rejecting Applicant’s claims.

G. Printing Consumables

On page 11, the Examiner argues that printing with a monochrome print head instead of color print heads would “deplete the monochrome print cartridge faster than if the color print cartridge were installed.” Examiner’s Answer, page 11, lines 7-9. This argument is flawed in that it contorts the clear meaning of Applicant’s claims in an attempt to force an interpretation that will be satisfied by the Moro reference. At issue is whether a print driver setting is likely to

result in consumption of large amounts of printing device consumables for that print job, not whether, over time, a certain print head will be depleted relatively faster. Regardless, such a situation does not result in greater “consumption” of consumables, but rather consumption of one type of consumable (e.g., black ink) instead of another type of consumable (e.g., colored ink).

H. Degree of Severity

The Examiner’s arguments on page 11 of the Examiner’s Answer as to providing an indication of “the degree of severity” of the adverse result are equally unwarranted. See Examiner’s Answer, page 11, lines 14-16. In essence, the Examiner is arguing that Moro teaches providing a message of a mismatch, thereby accounting for the “providing a notification” limitation, and teaches buttons in the message saying “continue” and “stop” that the user can select, thereby accounting for the “providing an indication of the degree of severity” limitation. Presenting buttons that allow the user to continue or stop printing is “providing an indication of the degree of severity” to the user of an adverse printing result? This argument makes so little sense that it is difficult to follow. Clearly, Moro only teaches providing one message; no indication of severity is provided. Applicant invites the Board to peruse the Moro disclosure for anything that remotely resembles “providing an indication of the degree of severity”.

I. Non-Entry of Claims 28-33

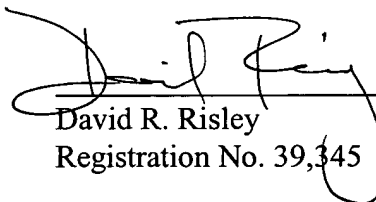
The Examiner states that the issue of non-entry of claims 28-33 is a petitionable matter. This may be true. However, given that filing of such a petition does nothing to toll the normal period of response to the final Office Action, Applicant recognizes the futility of such a petition, which would most likely not be decided for weeks or even months. Applicant addressed the issue

as to non-entry of claims 28-33 because Applicant believes that the Examiner's decision to not enter claims 28-33, which only contained limitations that the Examiner has considered and *expressly commented on*, reveals the Examiner's hostility toward allowing Applicant's claims. Therefore, the issue of the non-entry of Applicant's claims is believed to be relevant to this Appeal in judging the Examiner's actions in regard to the application. Moreover, Applicant recognizes that the Board has the authority to make binding recommendations to the Examiner and wishes the Board to recognize Applicant's willingness to pursue claims of different scope. Therefore, if, for example, the Board believes that one or more of the limitations of independent claims 1, 9, or 13 are individually patentable, Applicant would welcome such an indication from the Board.

CONCLUSION

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

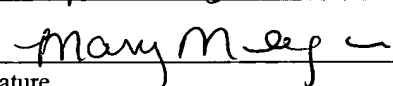
Respectfully submitted,



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12-2-05



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